Best Practices for Licensing of Genomic Inventions

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DRAFT

WORK IN PROGRESS

Comments and suggestions are invited

What We Fear

- Inhibit Innovation
- Inhibit Competition
- limit access to tools - Slow Research
- Shift from Basic to Applied Research

What Grantees Fear

- No Good Deed Goes Unpunished
- Slippery Slope to Gov't Regulation
- Easier Said Than Done
- Chill Licensing Interest
- Gov't Should Mind Its Own Business

Not All Innovations Require Further R&D to Meet Goals

Examples in Genomics

- Bulk Sequences
- Plasmids
- Cloning Tools/Vectors
- Libraries
- Databases
- Software
- Lab Techniques

If significant R&D is not needed

Consider

Not

Patenting

Potential Benefits

- Conserve Resources
- Commercially viable tools can be licensed without IPR
- Incremental improvements still advance field through publication

Not all Patents Require Exclusive Licensing

- Market sufficient to support competition
- Background Rights
  - Genus/Species
  - Product/Method of Use
- Bundles/Combines with Licensee's own Proprietary Technology
- Broad Enabling Technology
- Research Uses

Exclusive Licenses

- Ensure Appropriate Scope
- Ensure Expeditious Development

Appropriate Scope

- Limit to specific indications or fields of use
- Limit to specific territories
- Commensurate with Licensee's ability and commitment to develop

Expeditious Development

- Include developmental milestones/benchmarks
- Require performance-based royalty payments
- Monitor & enforce performance; include provisions to modify and terminate
- Sublicensing provisions & requirements

Take-Home Message

The good that patents do lives after them

The rest can be fixed by good licensing

So

Go For The Good